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In re Application of	:	DECISION ON
Han-Jie ZHOU et al	:	
PCT No.: PCT/US2004/001279	:	
Application No.: 10/541,441	:	
Int. Filing Date: 20 January 2004	:	PETITION UNDER
Priority Date: 17 January 2003	:	
Attorney's Docket No.: 09367.0046-00000	:	
For: COMPOUNDS, COMPOSITIONS,	:	
AND METHODS	:	37 CFR 1.47(a)

This is in response to the "PETITION FOR FILING DECLARATION UNDER 37 C.F.R. 1.47(a)- NON-SIGNING INVENTOR" filed on 17 January 2006. The \$200.00 petition fee has been charge to the Deposit Account No. 06-0916.

BACKGROUND

On 20 January 2004, applicants filed international application PCT/US2004/001279, which claimed priority of an earlier U.S. application filed 17 January 2003.

On 05 July 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, inter alia, the requisite basic national fee. No executed oath or declaration from the inventors accompanied the Transmittal Letter at such time.

On 23 November 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date" must be submitted within two months from its date of mailing or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 17 January 2006, petitioner filed the present petition accompanied, inter alia, an executed Declaration without the signature of one of the seven inventors, i.e., without the signature of Andrew I. McDonald.

DISCUSSION

Petitioner's petition under 37 CFR 1.47(b) is improper because this petition is for the circumstance when all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort. In this situation two of the four inventors signed the declaration. Accordingly, the petition has been treated under 37 CFR 1.47(a).

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the **37 CFR 1.47** applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See **MPEP § 106**. It is reasonable to require that the inventor be presented with the application papers before a petition under **37 CFR 1.47** is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the **37 CFR 1.47** applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied requirements (1), and (4) of 37 CFR 1.47(a). However, requirements (2) and (3) have not been satisfied.

Regarding item (2) it is unclear if the mailed documents were actually received by the non-signing inventor, Andrew I. McDonald, the signature section of the Certified Mail Receipt of the mailed letter on December 22, 2005 is signed by "J. Wright," (on December 23, 2005) not Andrew I. McDonald. It is unclear why the letters were not mailed to Mr. McDonald's last known address but instead mailed to ThinkEquity Partners LLC. In addition, petitioner has not offered any evidence or any affirmative statement that petitioner knows that Mr. McDonald is currently working at ThinkEquity Partners LLC. A quick cursory check at its website by the legal examiner was unable to locate his name. Accordingly, it is unclear if he actually received the documents or even if Mr. McDonald works at ThinkEquity Partners LLC and that he would have received the letters mailed and received there.

Regarding item (3), petitioner has not provided a statement of the last known address of the missing inventor.

Consequently, the current record does not support the premise that Mr. McDonald's conduct constitutes refusal because no evidentiary documents have been submitted to show that the complete application was delivered to them and that he refused to sign the required papers.

Accordingly, the petition has not met the requirements under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a). Failure to timely file the proper response will result in ABANDONMENT.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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